

FEB 16 2000

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PTO/SB/29 (8/98)

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Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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**CONTINUED PROSECUTION APPLICATION (CPA)
REQUEST TRANSMITTAL**

Submit an original, and a duplicate for fee processing.

(Only for Continuation or Divisional applications under 37 C.F.R. § 1.53(d))

CHECK BOX, if applicable:

 DUPLICATE

Address to:

Assistant Commissioner for Patents
Box CPA
Washington, DC 20231

Attorney Docket No. of Prior Application	SYN1
First Named Inventor	Moriarty
Examiner Name	Badio
Group / Art Unit	1616
Express Mail Label No.	EL214997374US

This is a request for a continuation or divisional application under 37 C.F.R. § 1.53(d),
(continued prosecution application (CPA)) of prior application number 09 / 008,957,
filed on 01/19/98, entitled 1α-Hydroxyvitamin D5.

NOTES

FILING QUALIFICATIONS: The prior application identified above must be a nonprovisional application that is either: (1) complete as defined by 37 C.F.R. § 1.51(b), or (2) the national stage of an international application in compliance with 35 U.S.C. 371. A Notice will be placed on a patent issuing from a CPA, except for reissues and designs, to the effect that the patent issued on a CPA and is subject to the twenty-year patent term provisions of 35 U.S.C. § 154(a)(2). Therefore, the prior application of a CPA may have been filed before, on or after June 8, 1995.

C-I-P NOT PERMITTED: A continuation-in-part application cannot be filed as a CPA under 37 C.F.R. § 1.53(d), but must be filed under 37 C.F.R. § 1.53(b).

EXPRESS ABANDONMENT OF PRIOR APPLICATION: The filing of this CPA is a request to expressly abandon the prior application as of the filing date of the request for a CPA. 37 C.F.R. § 1.53(b) must be used to file a continuation, divisional, or continuation-in-part of an application that is not to be abandoned.

ACCESS TO PRIOR APPLICATION: The filing of this CPA will be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public who is entitled under the provisions of 37 C.F.R. § 1.14 to access to, copies of, or information concerning, the prior application may be given similar access to, copies of, or similar information concerning, the other application or applications in the file jacket.

35 U.S.C. 120 STATEMENT: In a CPA, no reference to the prior application is needed in the first sentence of the specification and none should be submitted. If a sentence referencing the prior application is submitted, it will not be entered. A request for a CPA is the specific reference required by 35 U.S.C. 120 and to every application assigned the application number identified in such request, 37 C.F.R. § 1.78(a).

1. Enter the unentered amendment previously filed on _____ under 37 C.F.R. § 1.116 in the prior nonprovisional application.
2. A preliminary amendment is enclosed.
3. This application is filed by fewer than all the inventors named in the prior application, 37 C.F.R. § 1.53 (d-4).
 - a. **DELETE** the following inventor(s) named in the prior nonprovisional application:
.....
.....
.....
 - b. The inventor(s) to be deleted are set forth on a separate sheet attached hereto.
4. A new power of attorney or authorization of agent (PTO/SB/81) is enclosed.
5. Information Disclosure Statement (IDS) is enclosed:
 - a. PTO-1449
 - b. Copies of IDS Citations

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Burden Hour Statement: This form is estimated to take 0.4 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box CPA, Washington, DC 20231.

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CLAIMS	(1) FOR	(2) NUMBER FILED	(3) NUMBER EXTRA	(4) RATE	(5) CALCULATIONS
	TOTAL CLAIMS (37 C.F.R. § 1.16(c) or (i))	16 -20* =	0	x \$ 18 =	\$ 0
	INDEPENDENT CLAIMS (37 C.F.R. § 1.16(b) or (ii))	6 -3** =	3	x \$ 78 =	234
	MULTIPLE DEPENDENT CLAIMS (if applicable) (37 C.F.R. § 1.16(d))			+ \$ 260 =	0
				BASIC FEE (37 C.F.R. § 1.16)	690
			Total of above Calculations =		924
	Reduction by 50% for filing by small entity (Note 37 C.F.R. §§ 1.9, 1.27 & 1.28).				462
	* Reissue claims in excess of 20 and over original patent. ** Reissue independent claims over original patent.			TOTAL =	462

6. Small entity status:

- a. A small entity statement is enclosed, if (b) and (c) do not apply.
- b. A small entity statement was filed in the prior nonprovisional application and such status is still proper and desired.
- c. Is no longer claimed.

7. The Commissioner is hereby authorized to credit overpayments or charge the following fees to Deposit Account No. 50 - 0358:

- a. Fees required under 37 C.F.R. § 1.16.
- b. Fees required under 37 C.F.R. § 1.17.
- c. Fees required under 37 C.F.R. § 1.18.

8. A check in the amount of \$ 462 is enclosed.

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9. New Attorney Docket Number, if desired _____*[Prior application Attorney Docket Number will carryover to this CPA unless a new Attorney Docket Number has been provided herein.]*10. a. Receipt For Facsimile Transmitted CPA (PTO/SB/29A)b. Return Receipt Postcard (Should be specifically itemized, See MPEP 503)11. Other: _____

NOTE: *The prior application's correspondence address will carry over to this CPA UNLESS a new correspondence address is provided below.*

12. NEW CORRESPONDENCE ADDRESS

<input type="checkbox"/> Customer Number or Bar Code Label	(Insert Customer No. or Attach bar code label here)		<input type="checkbox"/> or <input type="checkbox"/> New correspondence address below
Name			
Address			
City	State	Zip Code	
Country	Telephone	Fax	

13. SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Name (Print /Type)	Harold J. Fassnacht
Signature	
Registration No. (Attorney/Agent)	35,507
Date	02/10/00

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION OF

Moriarty, R.M.; Penmasta, R.;
Guo, L.; Rao, M.S.;
and Mehta, R.G.

SERIAL NO.: 09/008,957

FILED: Jan. 20, 1998

TITLE: 1 α -HYDROXYVITAMIN D₅,
ITS SYNTHESIS AND USE
IN CANCER PREVENTION
AND THERAPY



Group No. 1616

Examiner: Badio

Assistant Commissioner for Patents
BOX CPA
Washington, D.C. 20231

PRELIMINARY REMARKS

In response to the Final Office Action of Sept. 10, 1999 and the Advisory Action dated January 4, 2000, Applicant offers the following remarks. Applicants request no amendments at this time.

Status of the Claims

Claims 1-19 are pending. Claims 7-9 have been withdrawn from consideration as being drawn to a non-elected invention. Claims 1-6 and 10-14 stand rejected under 35 U.S.C. § 103 over (1) Holick et al. '538, (2) Holick et al. '643 and (3) Bishop et al. '429. Claims 1-4 and 10-12 stand rejected under 35 U.S.C. § 103 over Gulbrandsen et al. '790. Claims 15-19 stand rejected under 35 U.S.C. § 103 over (1) Holick et al. '538, (2) Holick et al. '643 and (3) Bishop et al. '429. Claims 15-17 stand rejected under 35 U.S.C. § 103 over Gulbrandsen et al. '790. Applicant